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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,730	09/25/2003	Rod Ross	MO06009C1	9438
34408 7590 11/29/2008 THE ECLIPSE GROUP LLP 10605 BALBOA BLVD., SUITE 300 GRANADA HILLS, CA 91344				
EXAMINER				
NGUYEN, VI X				
ART UNIT		PAPER NUMBER		
3734				
MAIL DATE		DELIVERY MODE		
11/20/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/672,730

Applicant(s)

ROSS ET AL.

Examiner

Victor X. Nguyen

Art Unit

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-8, 14, 37-40 and 44-69 is/are pending in the application.
4a) Of the above claim(s) 6-8, 14 and 37-40 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 44-69 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. In response to applicant's amendment of 7/3/2008, the examiner has removed all prior 35 USC 112 rejections.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 44-62,64-69 are rejected under 35 U.S.C. 102(e) as being anticipated by Dybbs (6,228,099).

Dybbs discloses a blade assembly that can be assembled into a microkeratome, including: a blade (98) has a cutting edge (102) along a first direction(the first direction occurs along the segment of 102), a rear edge (see previous attached figure mailed out 1/8/08, where all yellow mark is characterized as a rear edge, the rear edge has a notch at the opening of blade 98), and a pair of side edges (occurs at either side of element 98), and a second side edge disposed at a distance from the first side edge along a second direction (the second direction occurs along the segment of element 98) where a blade holder (96) includes a reference surface (the reference surface locates at the anterior side of element 96 or at the front side of element 106 which generally faces toward the cutting edge 102 and an opening 122 configured to receive a pin 135

of the microkeratome, where the blade holder frictionally engaging the rear edge and movable relative to the rear edge by an amount adjustable along the first direction, where the blade holder reference surface is positioned at an adjustable distance from the cutting edge along the first direction (a functional limitation): thus, a reference needs not show the structure of the recitation in order to meet the claim language but rather the reference needs only be capable of being used with such structure. Accordingly, the reference is considered to read on the claimed limitation of the claimed noted, and where the blade can pivot relative to the blade holder, and where the blade holder also has an outer groove (fig.4), and where the blade holder includes a tapered top surface (see fig.3) and an opening is formed (at 138) in the tapered top surface. Regarding claims 46,48,50-52,57-59,63,65 and 67, Dybbs discloses a blade assembly, where the notch includes a first, a second inside edges 128, and a third edge 134 interposed between the first and second inside edges at best seen in fig. 9, and where the blade holder has an outer groove which engages the notch (see figures 4 and 7-9), where the blade includes a finger (the finger occurs along the opening of element 122) which extends outwardly from the notch (see fig. 4).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 63 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dybbs. Dybbs discloses the invention substantially as claimed. However, Dybbs is silent regarding the

finger has a thickness perpendicular to the area. Nevertheless, Dybbs does disclose the finger which has the finger edge extends along the direction of the thickness (see fig. 4), where changes in the size or thickness of a component involve merely routine skill in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make Dybbs' device with the finger has a thickness perpendicular to the area.

Response to Arguments

4. Applicant's remarks filed 7/3/2008 have been fully considered but they are not persuasive. Applicant states that Dybbs fails to suggest a blade holder frictionally engaging the rear edge and movable relative to the rear edge by an amount adjustable along the first direction. Examiner disagrees. In fact, as seen in fig. 3 of Dybbs, when viewed from a bird's eye point of view, it is possible for the blade 98 and the blade holder 96 to have some sort of movement relative to each other along the first direction. The examiner notes that the limitation "movable relative to the rear edge by an amount adjustable along the first direction" (a functional limitation): thus, a reference needs not show the structure of recitation in order to meet the claim language but rather the reference needs only be capable of being used with such structure. (See MPEP 2111.04 and MPEP 2112.01). Accordingly, the reference is considered to read on the claimed limitation of the claimed noted. Furthermore, the applicant argues that Dybbs fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *any means for providing calibration of the distance between any part of the blade holder and the cutting edge of the blade*) are not recited in the rejected **claim(s) 44,55 and 60**. Although the claims are interpreted in light of the specification, limitations from the specification

are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ho Jackie can be reached on (571) 272-4697. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin T. Truong/
Primary Examiner, Art Unit 3734

/Victor X Nguyen/
Examiner
Art Unit 3734

VN